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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,667	06/19/2001	Andre Luiz Arias	33764R003	7582
441	7590	01/11/2005	EXAMINER	
SMITH, GAMBRELL & RUSSELL, LLP 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,667

Applicant(s)

ARIAS ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 and 27-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 27-42 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed October 21, 2004 has been entered and fully considered.
2. Claims 19, 27-43 are present of which 40-43 are new.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 19, 27-40, 42 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended independent claim 19 and dependent claim 42 to require the composition to be the "outermost" coating on the lithographic printing plate. There is insufficient support in the specification for this limitation because the term "outermost" suggest it is possible for another coating to be present which is inconsistent with the specification. However, the Examiner agrees there is sufficient support in the specification for the composition being the "only" coating on the support because there is no teaching or suggestion of another coating.
5. The rejection of claims 19, 27-39 under 35 U.S.C. 103(a) over Tsuchiya et al. (US 5,786,125 A) in view of Lazarus et al. (US 4,943,511) is withdrawn in light of the new matter.

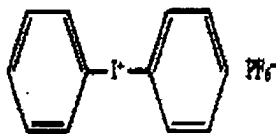
Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (US 5,786,125) in view of Ray et al. (US 6,562,527 B2) and Lazarus et al. (US 4,943,511).

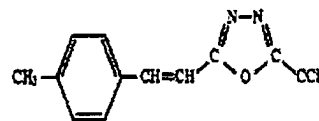
a. Tsuchiya exemplifies in examples 1-5 the preparation of a positive light sensitive lithographic printing plate. The substrate is an aluminum plate, which has been textured and anodized (c. 22, l. 65-c. 23, l. 7). The said plate is coated with a coating solution and dried to form a primer layer (c. 23, l. 8-11). A light sensitive layer is then coated on the primer layer and dried to a weight of 2 g/m². The light sensitive layer comprises (1) a carbon black dispersion; (2) bisphenol A-formaldehyde resol resin; (3) m-cresol-formaldehyde novolak resin; (4) an acid precursor; (5) a surfactant and (6) a solvent (c. 23, l. 26-c. 24, l. 20). Example 1 exemplifies the use of an acid precursor (III-



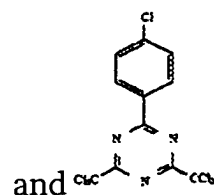
2) having the structure

(c. 8, l. 55; Table 1). Examples 3 and 5

used acid precursor (I-2) and (II-2) which have the structures:



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formaldehyde resol resin and m-cresol-formaldehyde novolak resin meets the limitations of the claimed dual polymer binder system wherein bisphenol A-formaldehyde resol resin is the second polymer which is the product of bisphenol A and an aldehyde and m-cresol-formaldehyde novolak resin is the first polymer which is the product of m-cresol and an aldehyde. It is the examiner's position that compound (III-2) meets the limitations of the claimed iodonium salt having a hexafluorophosphate anion. Specifically, compound (III-2) is diphenyliodonium hexafluorophosphate as set forth in instant claim 34. Compounds (I-2) and (II-2) meet the limitations of a dye derived from the oxazolyl class as set forth in instant claim 30. It is clear the light-sensitive layer of Tsuchiya may contain additives (c. 17, l. 49-64) however there is no teaching of a stabilizing acid in the light-sensitive layer. It would have been obvious to one of ordinary skill in the art to add a stabilizer such as a stabilizing acid to the light-sensitive layer of Tsuchiya in order to stabilize the layer over time as evidenced by the teachings of Ray et al. (c. 11, l. 44-53).

b. Example 1 further teaches applying a silicon rubber layer over the said light sensitive layer and laminating with a stretched polypropylene film to obtain a light sensitive lithographic printing plate. The resulting plate was exposed with a YAG laser; the laminated film was pressed off; the plate was heated and then developed.

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c. Tsuchiya fails to teach a curing step after development. Lazarus et al. (US 4,943,511) exemplifies a process wherein a positive working system was developed and then post-baked in an air circulating oven at about 150° C for 30 minutes to increase the adhesion and chemical resistance of the undissolved portions of the coatings (c. 14, l. 8-11). It is the examiner's position that Lazarus discloses what is well known and conventional in the art of photolithography. One of ordinary skill in the art would have been motivated by what is well-known and conventional in the art, as exemplified by Lazarus, to post-bake the developed system of Tsuchiya in order to increase the adhesion and chemical resistance of the undissolved portions of the coatings.

Allowable Subject Matter

8. Claim 43 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

a. The light-sensitive lithographic printing plate of Tsuchiya et al. (US 5,786,125) comprises a light-sensitive layer and a silicone rubber layer. There is no teaching or suggestion in Tsuchiya et al. of a light-sensitive lithographic printing plate comprising only the light-sensitive layer as required in instant claim 43.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
for Yvette C. Thornton
Primary Examiner
Art Unit 1752

bg
January 10, 2005